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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,396	08/17/2000	Mikhail F. Gordeev	6270.N DV1	7157

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Pharmacia & Upjohn Company
Global Intellectual Property
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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,396

Applicant(s)

Gordeev et al

Examiner

Maurie Garcia Baker, Ph. D.

Art Unit

1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 5, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 44-54 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-6 and 44-54 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Please note the change in examiner.

1. Applicant's Response and Election filed June 5, 2002 is acknowledged.
Applicant elected Group II (claims 44-48) and a single compound species. However, the previous election of species requirement is deemed by the new examiner to be insufficient and a ***new election of species requirement*** for each group is set forth below (paragraphs 11-14).
2. In the interest of clarity, the entire Restriction Requirement is set forth below, with groups and species both set forth. Some additional elaboration on the differences between groups is also added.
3. Moreover, the current examiner would like to point out that the previously elected species does not appear to read on the elected claims (Group II: claims 44-48). Namely the azido group does not appear to read on -NH-R₆. **Please note the new election of species requirement for this Group (and all other Groups), set forth below.** The new examiner would be happy to discuss this new Requirement via telephone if necessary.
4. Lastly, it is noted that some of the claims under consideration depend from cancelled claims. It would assist the examiner in the examination of the case if this problem was corrected in response to this action.

Election/Restriction

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a method for the solid phase synthesis of oxazolidinones and combinatorial libraries, classified in class 548, subclass 139 or class 435, DIG 49.
 - II. Claims 44-48, drawn to a method of preparing combinatorial libraries, classified in class 548, subclass 141 or class 435, DIG 49.
 - III. Claims 49-53, drawn to a method of synthesizing compounds, classified in class 548, subclass 163.
 - IV. Claim 54, drawn to a method of synthesizing compounds, classified in class 548, subclass 192.
6. The inventions are distinct, each from the other because of the following reasons:
7. From the previous action: "Inventions I – IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions employ different and distinct syntheses to make or alter the core".
8. Moreover, Groups I – IV are different methods. The methods are different because they use different steps, require different reagents and will produce different products and/or results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, each of the methods uses different steps that employ different reagents. For example, the method

of Group I requires an olefin that is oxidized to an epoxide. These steps are not present in any of the other methods. The method of Group II makes a library of compounds by functionalization at the 4-position of the aryl groups. This is different from the methods of Groups III and IV which make single compounds and do not require this functionalization step. Groups III and IV also require completely different steps, with Group III reciting “providing an iminophosphorane” and “mixing the iminophosphorane with a resin” while Group IV recites “reacting an amine with a resin”.

9. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. Please note that even though some of these groups could be classified in the same class or subclass, this has no effect on the non-patent literature search. The different methods would require completely different searches in these databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

10. This application contains claims directed to patentably distinct species of the claimed invention for **Groups I – IV**. Election is required as follows.

11. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Please elect *one* species from *each* subgroup below. Claims 1 and 4 are generic.

Species of compound/library

Applicant is required to elect, for purposes of search, a specific compound or library core that is made by the claimed method. That is, election of a single compound with all atoms and bonds defined.

Species of olefin

Applicant is required to elect, for purposes of search, a specific olefin that is used in the claimed method. A single compound with all atoms and bonds defined should be elected.

Species of amine

Applicant is required to elect, for purposes of search, a specific amine that is used in the claimed method. A single compound with all atoms and bonds defined should be elected.

Species of "phosgene equivalent"

Applicant is required to elect, for purposes of search, a specific "phosgene equivalent" that is used in the claimed method.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

12. If applicant elects the invention of Group II, applicant is required to elect from the following patentably distinct species. Please elect *one* species from *each* subgroup below. Claim 44 is generic.

Species of library

Applicant is required to elect, for purposes of search, a specific library that is made by the claimed method. That is, selection of each and every variable group to result in a single library core compound with all atoms and bonds defined. The core compound should be common to all library members.

Species of aryl oxazolidinones

Applicant is required to elect, for purposes of search, a specific aryl oxazolidinone that is used in the claimed method. A single compound with all atoms and bonds defined should be elected.

Species of attachment to solid support

- (1) Through reaction of iminophosphorane; claims 45 and 47
- (2) Through reaction of an amine; claims 46 and 48

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

13. If applicant elects the invention of Group III, applicant is required to elect from the following patentably distinct species. Please elect *one* species from *each* subgroup below. Claims 49, 52 and 53 are generic.

Species of compound

Applicant is required to elect, for purposes of search, a specific compound that is made by the claimed method. That is, selection of each and every variable group to result in a single compound with all atoms and bonds defined.

Species of iminophosphorane

Applicant is required to elect, for purposes of search, a specific iminophosphorane that is used in the claimed method. A single compound with all atoms and bonds defined should be elected.

Species of "providing" iminophosphorane

- (1) From an azide; claim 50
- (2) From an amine; claim 51

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

14. If applicant elects the invention of Group VI, applicant is required to elect from the following patentably distinct species. Please elect *one* species from *each* subgroup below. Claim 54 is generic.

Species of compound

Applicant is required to elect, for purposes of search, a ***specific*** compound that is made by the claimed method. That is, selection of each and every variable group to result in a single compound with all atoms and bonds defined.

Species of amine

Applicant is required to elect, for purposes of search, a ***specific*** amine that is used in the claimed method. A single compound with all atoms and bonds defined should be elected.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

15. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

16. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon***, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

17. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

18. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

19. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

21. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

24. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this

Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Maurie Garcia Baker, Ph.D.
August 19, 2002

A handwritten signature in black ink, consisting of stylized, cursive letters 'M' and 'B' followed by a long horizontal flourish.

**MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER**



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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